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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/542,005

Filing Date: July 12, 2005

Appellant(s): KAKU, JUNYA

Nick Bromer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 09, 2008 appealing from the Office action mailed June 6, 2008

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct .

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 4, 6 – 15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamaguchi et al. US 6,795,097 B1 (hereinafter referred as Yamaguchi).

As per Claim 1, Yamaguchi discloses “a data-storage medium containing a data structure of menu display control data which is read out by a processor of a display device displaying a menu image” as a list data supplied for the job dial compatible application for displaying menu (Yamaguchi, column 22, lines 43 - 46).

Yamaguchi discloses “a plurality of first management tables each of which manages a plurality of large items to be subjected to a display process by said processor” as a list menu item data D100 managing individual menu item corresponding to various modes and functions displayed in the item display area (Yamaguchi, column 17, lines 51 - 54).

Yamaguchi discloses "a plurality of second management tables which belong to each of said plurality of first management tables" as a list data D101 corresponding to menu item at a lower level than list data D100 (Yamaguchi, column 18, lines 55 - 58).

Yamaguchi discloses "and each of which manages a plurality of small items to be subjected to a display process by said processor" as based on list data D101, a plurality of menu items are displayed corresponding to menu item (Yamaguchi, Column 18, lines 64 - 67).

Yamaguchi discloses "wherein dependency relationship information indicative of dependence on a small item managed under a first management table different from the first management table to which a noticed second management table belongs is assigned to said noticed second management tale" as a duplication status flag indicates two kinds of menu items exist or not (Yamaguchi, column 17, lines 46 – 50). Thus, return, still, long video, and video mail sub menu items are assigned to both simple menu and capture mode in the detailed menu (Yamaguchi, column 20, lines 18 – 27; Fig. 35).

That is, the flag D100e is a duplication status flag (Yamaguchi, Figure 31A). It indicates that two kinds of menu items exist or not for given displaying menu items (Yamaguchi, column 17, lines 16 - 21). Therefore, such flag does have connection between the menus and teach as an indicative showing if the menu item is depending on two kinds of menu items.

Yamaguchi discloses "so that, when a desired small item is selected, said processor can display a plurality of small items dependent on said desired small item,

Art Unit: 2165

based on said dependency relationship information" as when shift key is pressed, [detailed menu] and [simple menu] sub menus are displayed for further selection of menu items (Yamaguchi, column 20, lines 24 – 27).

As Yamaguchi further describes, when the Shift key is pressed, the CPU (50) displays the menu items ([Detailed Menu] and [Simple Menu]) corresponding to the depression of the Shift key in the item display area (301) of the guidance status job-dial window (300) and if menu item [Simple menu] is selected by the user, displays the [Capture Mode] menu items ([Return], [Still], [Long Video], and [Video Mail]) corresponding to that [Simple Menu], and then proceeds to the next step SP46 (Yamaguchi, column 20, lines 59 – 67, Figure 36).

That is, when the simple menu is specified by the user, menu items of [Return], [Still], [Long Video], and [Video Mail] are displayed and activated. Therefore, Yamaguchi does teach the limitation of *when a desired small item is selected, specifies a plurality of small items dependent on said desired small item.*

As per Claim 2, and also applied to Claim 1, Yamaguchi discloses "wherein desired small item information indicative of said desired small item is assigned to the first management table managing said desired small item, so that said processor can display said desired small item instead of a large item corresponding to said desired small item, based on said desired small item information" as the CPU rewrites the title of the title display area from [Smart Capture] to [Capture mode] when [Capture mode]

menu item is selected from the [Smart Capture] menu list (Yamaguchi, column 18, lines 47 – 50; lines 61 – 62).

As per Claim 3, and also applied to Claim 2, Yamaguchi discloses "wherein said desired small item information is switched to small item unselected information when said desired small item is deselected, so that said processor can display the large item corresponding to said desired small item instead of said desired small item, based on said small item unselected information" as when menu item [return] is selected, the CPU 50 returns the job-dial window to the menu display corresponding to [Smart Capture] in Fig. 30 (Yamaguchi, column 19, lines 40 - 43).

As per Claim 4, and also applied to Claim 1, Yamaguchi discloses "wherein unselectable information is assigned to the first management table to which a second management table dependent on a small item of the second management table in which said desired small item is not selected belongs, so that said processor can suspend display of the large items managed by the first management table to which said unselectable information is assigned" as a duplication status is assigned to [Smart Capture] menu data indicating if two kinds of menus are selectable or not (Yamaguchi, column 17, lines 46 -50 and Fig. 35).

As per Claim 6, and also applied to Claim 1, Yamaguchi discloses "wherein said dependency relationship information can be indicative of dependency relationships

Art Unit: 2165

with a plurality of small items" as a duplication status flag indicates two kinds of menu items exist or not (Yamaguchi, column 17, lines 46 – 50). Thus, return, still, long video, and video mail sub menu items are assigned to both simple menu and capture mode in the detailed menu (Yamaguchi, column 20, lines 18 – 27; Fig. 35).

As per Claim 7, and also applied to Claim 1, Yamaguchi discloses "A data structure according to claim 1, comprising file storing menu display control data" as a program storage medium used to install the jog-dial utility program (Yamaguchi, column 26, lines 4 – 14).

As per Claim 8, Claim 8 is a system performing the methods disclosed in Claim 1. The limitations are substantially the same as Claim 1; therefore, the rejection of Claim 1 also applies to Claim 8.

As per Claim 9, Claim 9 is a system performing the methods disclosed in Claim 2. The limitations are substantially the same as Claim 2; therefore, the rejection of Claim 2 also applies to Claim 9.

As per Claim 10, Claim 10 is a system performing the methods disclosed in Claim 3. The limitations are substantially the same as Claim 3; therefore, the rejection of Claim 3 also applies to Claim 10.

As per Claim 11, Claim 11 is a system performing the methods disclosed in Claim 4. The limitations are substantially the same as Claim 4; therefore, the rejection of Claim 4 also applies to Claim 11.

As per Claim 12, and also applied to Claim 8, Yamaguchi discloses "a photographing means for photographing an object" as a camera unit 22 is included in the main unit (Yamaguchi, column 5, lines 1 – 11).

Yamaguchi also discloses "a creating means for creating an image file containing an image signal of the object photographed by said photographing means and menu information including said desired small item" as image data can be generated by the video capture processing chip and store in a hard drive (Yamaguchi, column 8, lines 36 - 41) and the main unit has a jog-dial for menu selection (Yamaguchi, column 16, lines 21 - 37).

As per Claim 13, an also applied to Claim 2, Yamaguchi discloses "a data structure according to claim 2, comprising file storing menu display control data" as a program storage medium used to install the jog-dial utility program (Yamaguchi, column 26, lines 4 – 14).

As per Claim 14, an also applied to Claim 3, Yamaguchi discloses "file storing menu display control data" as a program storage medium used to install the jog-dial utility program (Yamaguchi, column 26, lines 4 – 14).

As per Claim 15, an also applied to Claim 4, Yamaguchi discloses "file storing menu display control data" as a program storage medium used to install the jog-dial utility program (Yamaguchi, column 26, lines 4 – 14).

As per Claim 17, an also applied to Claim 6, Yamaguchi discloses "file storing menu display control data" as a program storage medium used to install the jog-dial utility program (Yamaguchi, column 26, lines 4 – 14).

(10) Response to Argument

1. Applicant's arguments in the appeal brief filed October 9, 2008 have been fully considered but they are not persuasive.

2. On page 12, lines 3 – 5, regarding claims 1 and 8, Appellant argues that: Yamaguchi contains no disclosure of cross-referencing between different branches of a tree-like data structure, which distinguishes the Appellant's claims from the reference.

Examiner responds:

As to the above argument, the Examiner respectfully submits that such limitation regarding "cross-referencing between different branches of a tree-like data structure" is not recited in any of the claims.

Please further note *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. > *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

3. On page 12, lines 6 – 17, regarding claims 1 and 8, Appellant argues that:

The Examiner equates Yamaguchi's shift key to the Appellant's dependency relationship. This is not correct. The ability to navigate a tree menu does not imply that any items in the tree have any relationship, whether of dependency of any kind. All it implies is that the user can reach desired items, by the arbitrary actions of the user.

Examiner responds:

Yamaguchi teaches navigation to submenu is actually is an arbitrary actions of the user but is configured according to a hierarchical structure (See Yamaguchi, column 20, lines 18 – 27 and Figure 35, e.g. a menu configured by two kinds of hierarchical structure as shown in Figure 35). That is, the items in Yamaguchi's menu do have relationships which are defined by the hierarchical structure shown in Figure 35. Therefore, Yamaguchi does teach the dependency relationship of the present application.

4. On page 12, lines 18 – 23 and page 13, lines 1 - 2, regarding claims 1 and 8, Appellant argues that:

Yamaguchi does not disclose anything which, *when a desired small item is selected, specifies a plurality of small items dependent on said desired small item*, as recited in claim 8 or the corresponding features in claim 1 because if the user selects, say, STILL, there is no plurality of other items that have some special relationship with STILL (e.g. dependency relationship). When the user selects STILL, nothing jumps up in front of the user, nothing is displayed, nothing is activated; nothing is "specified". Neither LONG VIDEO, nor RETURN, nor VIDEO MAIL is specified, from either menu. Furthermore, no plurality of other items is specified.

Examiner responds:

Yamaguchi discloses "when a desired small item is selected, said processor can display a plurality of small items dependent on said desired small item, based on said dependency relationship information" as when shift key is pressed, [detailed menu] and [simple menu] sub menus are displayed for further selection of menu items (Yamaguchi, column 20, lines 24 – 27) based on the configured hierarchical structure (Yamaguchi, column 20, lines 18 – 24).

As Yamaguchi further describes, when the Shift key is pressed, the CPU (50) displays the menu items ([Detailed Menu] and [Simple Menu]) corresponding to the depression of the Shift key in the item display area (301) of the guidance status job-dial window (300) and if menu item [Simple menu] is selected by the user, displays the [Capture Mode] menu items ([Return], [Still], [Long Video], and [Video Mail]) corresponding to that [Simple Menu], and then proceeds to the next step SP46 (Yamaguchi, column 20, lines 59 – 67, Figure 36).

That is, when the simple menu is specified by the user, menu items of [Return], [Still], [Long Video], and [Video Mail] are displayed and activated. Therefore, Yamaguchi does teach the limitation of *when a desired small item is selected, specifies a plurality of small items dependent on said desired small item.*

5. On page 13, lines 4- 8, the Appellant argues that Appellant sees no anticipation by flag D100e because the Examiner has established no connection between this flag and the simple and detailed menus or item menus.

The Examiner responds:

Yamaguchi discloses "wherein dependency relationship information indicative of dependence on a small item managed under a first management table different from the first management table to which a noticed second management table belongs is assigned to said noticed second management table" as a duplication status flag indicates two kinds of menu items exist or not (Yamaguchi, column 17, lines 46 – 50). Thus, return, still, long video, and video mail sub menu items are assigned to both simple menu and capture mode in the detailed menu (Yamaguchi, column 20, lines 18 – 27; Fig. 35).

That is, the flag D100e is a duplication status flag (Yamaguchi, Figure 31A). It indicates that two kinds of menu items exist or not for given displaying menu items (Yamaguchi, column 17, lines 16 - 21). Therefore, such flag does have connection between the menus and teach as an indicative showing if the menu item is depending on two kinds of menu items.

6. On page 13, lines 9 - 15, regarding claims 1 and 8, Appellant argues that Yamaguchi fails to teach or suggest the display menus recited in claim 8 because the limitation of specifier that specifies a plurality of small items being dependent on a desired small item based on the dependency relationship information when the desired small item is selected is not anticipated by Yamaguchi.

The Examiner responds:

Yamaguchi teaches:

"said display includes a specifier which, when a desired small item is selected, specifies a plurality of small items dependent on said desired small item, based on said dependency relationship information" as when the Shift key is pressed, the CPU (50) displays the menu items ([Detailed Menu] and [Simple Menu]) corresponding to the depression of the Shift key in the item display area (301) of the guidance status job-dial window (300) and if menu item [Simple menu] is selected by the user, displays the [Capture Mode] menu items ([Return], [Still], [Long Video], and [Video Mail]) corresponding to that [Simple Menu], and then proceeds to the next step SP46 (Yamaguchi, column 20, lines 59 – 67, Figure 36).

That is, the CPU in Yamaguchi teaches as a specifier for specifying a plurality of small items of [Return], [Still], [Long Video], and [Video Mail] which are depending on the [Capture Mode] menu item.

7. On page 13, lines 16 – 19, regarding claims 1 and 8, the Appellant argues that Yamaguchi does not disclose a menu display apparatus capable of coping with a variety menu display by means of the same program.

Examiner responds:

As to the above argument, the Examiner respectfully submits that such limitation regarding " a menu display apparatus capable of coping with a variety menu display by means of the same program" is not recited in any of the claims.

Please further note In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. > E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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